

REMARKS/DISCUSSION OF ISSUES

Claims 1-10 and 12-22 are pending in the application.

Applicant respectfully requests that the Finality of the Office Action be withdrawn, and also respectfully requests reexamination and reconsideration of the application in light of the following remarks.

REQUEST FOR WITHDRAWAL OF HOLDING OF FINALITY OF OFFICE ACTION

The Office Action dated 2 July 2008 has been held by the Examiner to be final.

Applicant respectfully submits that the holding of Finality is improper, and respectfully requests that it be withdrawn, for at least the following reasons.

M.P.E.P. § 706.07(a) states that *"a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims."*

Here, the Final Office Action rejects claim 1 using a new ground of rejection introduced by the examiner which was not necessitated by amendment to the claim.

In response to the first Office Action, Applicant amended claim 1 to include the ball bearings of originally-filed claim 11, and then canceled claim 11.

The originally-filed claim 11 was rejected in the first Office Action under 35 U.S.C. § 103 over van der Heide U.S. Patent 5,388,568 ("van der Heide") in view of Hall U.S. Patent 3,788,303 ("Hall").

In this "Final" Office Action, the Examiner now rejects claim 1 - which was amended to recite the ball bearings features of originally-filed claim 11 - under 35 U.S.C. § 103 over Krauter U.S. Patent 5,464,007 ("Krauter") in view of van der Heide and Opie U.S. Patent 4,825,850 ("Opie").

This is a new ground of rejection that was not necessitated by any amendment. Neither Krauter nor Opie was cited against the originally-filed claim 11. Indeed, Krauter is not even cited for anything to do with the ball bearings imported from claim 11 into claim 1, so its addition could not possibly have anything to do with any amendment. Furthermore, the Hall reference which was cited in the first Office Action is no longer cited against this claim - clearly in response to Applicant's

arguments that it did not disclose what it was purported to disclose regarding ball bearings, and not in response to any claim amendment.

Accordingly, for at least these reasons, Applicant respectfully submits that the "Finality" of the Office Action dated 2 July 2008 is in violation of M.P.E.P. § 706.07(a), is improper, and should be withdrawn.

35 U.S.C. § 103

The Office Action rejects claims 1-8 and 12-21 under 35 U.S.C. § 103 over Krauter U.S. Patent 5,464,007 ("Krauter") in view of van der Heide U.S. Patent 5,388,568 ("van der Heide") and further in view of Opie U.S. Patent 4,825,850 ("Opie"); claims 9-10 under 35 U.S.C. § 103 over Krauter, van der Heide, Opie and Hall U.S. Patent 3,788,303 ("Hall"); and claim 22 under 35 U.S.C. § 103 over Krauter, van der Heide, Opie and Rio U.S. Patent Publication 2003/0219184 ("Rio").

Applicant respectfully traverses all of those rejections for at least the following reasons.

Claim 1

Among other things, the mechanism of claim 1 includes an intermediate shaft arranged at least partially inside of the second pinion shaft and at least partially around the first pinion shaft, the intermediate shaft being arranged to reduce transmission of torque between the first and second pinion shafts such that rotation of one of the first and second pinion shafts does not cause rotation of the other of the first and second pinion shafts, the intermediate shaft being axially unrestrained such that movement of the intermediate shaft in an axial direction is possible.

No combination of the cited art would ever produce a mechanism including an intermediate shaft with this combination of features.

At the outset, the Office Action fairly admits that Krauter does not disclose a mechanism that includes an intermediate shaft. So the Office Action cites van der Heide as disclosing an intermediate shaft as element 6a.

However, claim 1 recites that the intermediate shaft is axially unrestrained such that movement of the intermediate shaft in an axial direction is possible.

Van der Heide does not disclose that its “intermediate shaft” 6a is axially unrestrained such that movement of the intermediate shaft in an axial direction is possible. Indeed, to the contrary, van der Heide specifically and repeatedly teaches that element 6a is a fixed sleeve.

Without mentioning or addressing this, the Office Action instead states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified element 6a in van der Heide to be contrary to van der Heide’s specific teaching of a fixed sleeve, so that instead it would be axially unrestrained such that movement in an axial direction is possible:

“in order to have made it possible for the intermediate shaft to have been separable, adjustable, rotatable, or even in order to have made it easier to repair the control mechanism as desired, since it has been held that the separation of elements, where removability would be desirable, is a design consideration within the skill of the art. In re Dulberg, 283 F.2d 522, 129 USPQ 348 (CCPA 1961). It has also been held that adjustability, where desirable, is a modification that is within the skill of the art. In re Stevens, 212 F.2d 197, 101 USPQ 284 (CCPA 1954).”

Applicant respectfully traverses the proposed modification of van der Heide’s fixed sleeve 6a to make it axially unrestrained such that movement in an axial direction is possible, for at least the following reasons.

First, the recited feature has nothing to do with “*removability*,” and so the citation of In re Dulberg is inapplicable.

Second, the Office Action fails to provide any objective evidence whatsoever that anyone of skill in the art at the time the invention was made would have recognized any such “*removability*” to be desirable with respect to van der Heide’s fixed sleeve 6a. So the proposed modification is improper. KSR International Co. v. Teleflex Inc., 550 U.S. at ___, 82 USPQ2d 1385, 1396 (Fed. Cir. 2007) (quoting In re

Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

Third, the recited feature at issue does not recite “*adjustability*.” In re Stevens pertained to a fishing rod, where the claims at issue specifically recited an adjustable grip. The feature at issue here is intermediate shaft being axially unrestrained such that movement of the intermediate shaft in an axial direction is possible. There is no recitation of any adjustability in this feature. Therefore, whatever the continued vitality of In re Stevens may be today, it is inapplicable here.

Fourth, a mere statement that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness. M.P.E.P. § 2143.01(IV).

For at least these reasons, Applicant respectfully traverses the proposed modification of van der Heide's fixed sleeve 6a to make it axially unrestrained such that movement in an axial direction is possible, so as to try to read on Applicant's claim 1.

Also among other things, the mechanism of claim 1 includes first ball bearings arranged between the intermediate shaft and one of the first and second pinion shafts for enabling rotation of the one of the first and second pinion shafts relative to the intermediate shaft.

The Office Action fairly admits that no combination of Krauter and van der Heide would produce a mechanism including these features.

However, the Office Action states that Opie discloses ball bearings, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Krauter and van der Heide to include first ball bearings arranged between the intermediate shaft and one of the first and second pinion shafts for enabling rotation of the one of the first and second pinion shafts relative to the intermediate shaft:

“in order to have provided an improved endoscope having easily removable wheels so that the wheels can be either sterilized or discarded after use, facilitating the longevity and durability of the

endoscope device for long period of time which results in long-term cost savings for outpatient surgical centers."

Applicant respectfully traverses the proposed modification of Krauter and van der Heide, and also submits that it would not produce the mechanism of claim 1 with its first ball bearings arranged between the intermediate shaft and one of the first and second pinion shafts for enabling rotation of the one of the first and second pinion shafts relative to the intermediate shaft, for at least the following reasons.

First, Opie does not disclose or suggest ball bearings arranged between an intermediate shaft and either a first or second pinion shaft for enabling rotation of the one of the first and second pinion shafts relative to the intermediate shaft. In that regard:

- i) ball bearings 160 are not arranged between an intermediate shaft and either a first or second pinion shaft;
- ii) elements 150,154 are not any intermediate shaft;
- iii) the citation of the entire text of cols. 7 & 8 is deemed non-responsive as it is facially apparent that at least the first 51 lines of col. 7 do not relate to any of the elements cited in the Office Action;
- iv) ball bearings 244,246 are not arranged between an intermediate shaft and either a first or second pinion shaft;
- v) "two surfaces" ≠ an intermediate shaft and either a first or second pinion shaft;

Second, the Office Action does not provide any evidence that the addition of ball bearings arranged between an intermediate shaft and either a first or second pinion shaft for enabling rotation of the one of the first and second pinion shafts relative to the intermediate shaft is either a necessary or a sufficient condition to "provide an improved endoscope having easily removable wheels so that the wheels can be either sterilized or discarded after use, facilitating the longevity and durability of the endoscope device for long period of time which results in long-term cost savings for outpatient surgical centers," and so there is no rational underpinning for

the proposed modification. KSR International Co. v. Teleflex Inc., 550 U.S. at ___, 82 USPQ2d 1385, 1396 (Fed. Cir. 2007).

So, Applicant respectfully traverses the proposed combination of Opie with Krauter and van der Heide as having no articulated rationale supported by rational underpinnings, and furthermore respectfully submits that any such combination in any event would not produce the mechanism of claim 1.

Accordingly, for at least these reasons, Applicant respectfully submits that claim 1 is patentable over the cited art.

Claims 2-8 and 12-13

Claims 2-8 and 12-13 depend from claim 1 and are deemed patentable over the cited art for at least the reasons set forth above with respect to claim 1.

Claim 14

Among other things, the control and sealing mechanism of claim 14 includes first ball bearings arranged between an intermediate shaft and either first or second pinion shafts for enabling rotation of the first or second pinion shaft relative to the intermediate shaft.

As explained above with respect to claim 1, Applicant respectfully submits that no combination of the cited art would ever produce a control and sealing mechanism including this combination of features.

Accordingly, for at least these reasons, Applicant respectfully submit that claim 14 is patentable over the cited art.

Claims 15-21

Claims 15-21 depend from claim 14 and are deemed patentable over the cited art for at least the reasons set forth above with respect to claim 1.

Claims 12-13 and 22

Claims 12-13 and 22 depend from claim 1. Applicant respectfully submits that Hall and Rio do not remedy the shortcomings of the art as set forth above with respect to claim 1. Therefore, claims 12-13 and 22 are deemed patentable over the cited art for at least the reasons set forth above with respect to claim 1.

CONCLUSION

In view of the foregoing explanations, Applicant respectfully requests that the Examiner reconsider and reexamine the present application, allow claims 1-10 and 12-22 and pass the application to issue. In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact Kenneth D. Springer (Reg. No. 39,843) at (571) 283.0720 to discuss these matters.

Respectfully submitted,

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